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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,475	10/15/1999	BARRY MARKWITZ	6002-11	1318

		EXAMINER
7590	12/23/2003	TSAI, CAROL S W

Lawrence E. Laubscher, Sr.
EFS Customer No. 30267311
745 South 23rd Street
Arlington, VA 22202

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/419,475	MARKWITZ ET AL.
	Examiner	**Art Unit**	
	Carol S Tsai	2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 November 2003</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>36 and 37</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>36 and 37</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4)☐ Interview Summary (PTO-413) Paper No(s). _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

1.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S.

Patent No. 5,166,499 to Holland et al.

Holland et al. disclose a computer program product for use with a data processing system

for monitoring and evaluating guard patrols of one or more sites, the computer program product

comprising: (a) a computer usable medium including: (1) computer readable program code

means embodied in the medium (bar code reader 36 shown on Figs. 1 and 2) for gathering

information obtained from one or more checkpoints during a guard patrol of one or more sites

(see col. 1, line 57 to col. 2, line 5 and col. 3, line 45 to col. 4, line 49); (2) computer readable

program code means embodied in the medium for detecting when the gathered information is

ready to be downloaded into the data processing system (see Fig. 14 and col. 9, lines 4-19); (3)

computer readable program code means embodied in the medium for downloading the gathered

information into the data processing system (see Fig. 1 and col. 3, lines 55-66); and (b) computer

readable program code means (report generating software 22 shown on Fig. 1) for printing one or

more reports to a printer of the information obtained from one or more checkpoints during a

guard patrol, reports comprising customization selected from the group consisting of logos, cover

sheets, photographs, detailed headings, watermarks, bitmaps, drawings, illustrations, trademarks

and patrol statistics (see Tables 1-3; Figs. 14 and 15; col. 2, line 67 to col. 3, line 24; and col. 9,

line 20 to col. 10, line 15).

As to claim 37, Holland et al. also disclose a computer program product for use with a

data processing system for monitoring and evaluating guard patrols of one or more sites, the

computer program product comprising: (a) a computer usable medium including: (1) computer

readable program code means embodied in the medium (bar code reader 36 shown on Figs. 1 and

2) for gathering information obtained from one or more checkpoints during a guard patrol of one

or more sites (see col. 1, line 57 to col. 2, line 5 and col. 3, line 45 to col. 4, line 49); (2)

computer readable program code means embodied in the medium for detecting when the

gathered information is ready to be downloaded into the data processing system (see Fig. 14 and

col. 9, lines 4-19); (3) computer readable program code means embodied in the medium for   .

downloading the gathered information into the data processing system (see Fig. 1 and col. 3,

lines 55-66); and (b) computer readable program code means for downloading gathered

information into the data processing system independently of the computer program product (see

Fig. 1 and col. 3, lines 60-66).

Response to Arguments

4.   Applicant's arguments filed 11/17/2003 have been fully considered but they are not

persuasive.

Applicants argue that the cited first and second sections of the Holland et al. do not anticipate the provision of applicant's attendant computer readable program code means for downloading the gathered information into the data processing system independently of the computer program product because 1) the first section does not describe the association of graphics of checkpoints and that applicant's system does not associate priorities with checkpoints and 2) the second section does not discuss non-graphical data such as phonographs and snaps, that it does discuss non-graphical, text-based, statistics on the reports. The Examiner disagrees with Applicants. Holland et al. do not disclose the association of graphics of checkpoints and non-graphical data such as phonographs and snaps; however, as Applicants mentioned above that Holland et al. discussing non-graphical, text-based, statistics on the reports, is clearly meet the feature of Applicants' claimed elements, "reports comprising customization **selected from the group consisting of** logos, cover sheets, photographs, detailed headings, watermarks, bitmaps, drawings, illustrations, trademarks and **patrol statistics**".

Applicants argue that the first cited section of Holland et al. does not describe any independent program whose purpose is to handle external data collection devices and store their data in the central computer. The Examiner disagrees with Applicants. Applicants remain silent about the second cited section of Holland et al. that discloses gathering information obtained from one or more checkpoints during a guard patrol of one or more sites but instead of arguing about the first cited second of Holland et al. that the first section refers to the display of messages or prompts on the data, collection device that can help guide an inexperienced guard to the next zone or checkpoint on a tour and when a guard reads a given checkpoint a message associated with the next checkpoint is displayed. As set for the above, the cited second section (col. 3, line

45 to col. 4, line 49) of Holland et al. clearly disclose gathering information obtained from one or

more checkpoints during a guard patrol of one or more sites, whereas the first second (col. 1, line

57 to col. 2, line 5) disclosed in the "SUMMARY OF THE INVENTION" of Holland et al. is

only an additional part of information cited by the Examiner for extra explanation of the

teaching.

Applicants argue that Fig. 14 is a flowchart of the Holland et al.'s software and the cited

section (col. 9, lines 4-19) to which the Examiner refers describes a menu choice within the

Holland software that downloads a tour record from the portable data collector in which the

software requires a password of the user and then after monthly maintenance displays a main

menu and waits for a selection, that in other words, the Holland et al. download routine is part of

anther larger program, and it requires that larger program be active before the download routine

can run, that it is not an independent program like Applicant's program, which is running

whenever the computer is running, constantly monitoring external devices. The Examiner

disagrees with Applicants. It is noted that the features upon which applicant relies (i.e., an

independent program, which is running whenever the computer is running, constantly monitoring

external devices) are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims. See *In

re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As set forth above, Holland et

al. do disclose computer readable program code means embodied in the medium for detecting

when the gathered information is ready to be downloaded into the data processing system

(download tour defining record to tour monitor 20 shown on Fig. 14) (see Fig. 14 and col. 9,

lines 4-19).

Applicants argue that the cited section of column 3, lines 55-66 describes the connection

of a cable between the portable data collection device and the computer when it is desired to

transmit information to or from the computer, that taken together with the section previously

referred to by the Examiner we have a system where, in order to download information, a person

must: (1) Connect a cable between the computer and portable data collection device, (2)

Manually activate software on the computer and enter a password, and(3) Manually select the

proper menu choice to transfer the data. The Examiner disagrees with Applicants. The examiner

broadly interprets the claimed language differently from Applicant. As set forth in the art

rejection, Holland et al. do disclose computer readable program code means embodied in the

medium for downloading the gathered information into the data processing system (see Fig. 1

and col. 3, lines 55-66; <u>A cable 42 can be used to interconnect the monitor 30 with the computer</u>

<u>12 when desired to transfer programming information from the computer 12 to the monitor 30, or</u>

<u>**to transmit a tour log back from the monitor 30 to the computer 12.** When the tour monitor</u>

<u>30 is actually being carried through a tour, it is of course disconnected from a computer 12 and</u>

<u>used as a stand alone unit</u>).

Applicants argue that Applicant's system does not require the portable data collection

device to have any ability to display messages but instead, graphics such as photographs and

maps are printed in various reports. The Examiner disagrees with the Applicants. "FIG. 4 shows

the functional blocks that make up direct downloader 16 of the present invention. Direct

downloader 16 may also include I/O board 94 and communications port 104 which handle

communication between the communications port (not shown) of central computer 14 and

control plug-and-play dynamic hardware identification. Direct downloader 16 also includes

indicators 92 and test logic 90. Indicators 92 display the status of data transfer and power

supplied to the downloader 16. When reader 24 is placed in reader port 32 (reference numeral

102 of FIG. 4) test logic 90 provides pass/fail indication for the primary battery 52 for reader 24"

described at page 10, lines 13-20 of Applications' Specification clearly indicates that portable

data collection device, downloader 16, have ability to display the status of data transfer.
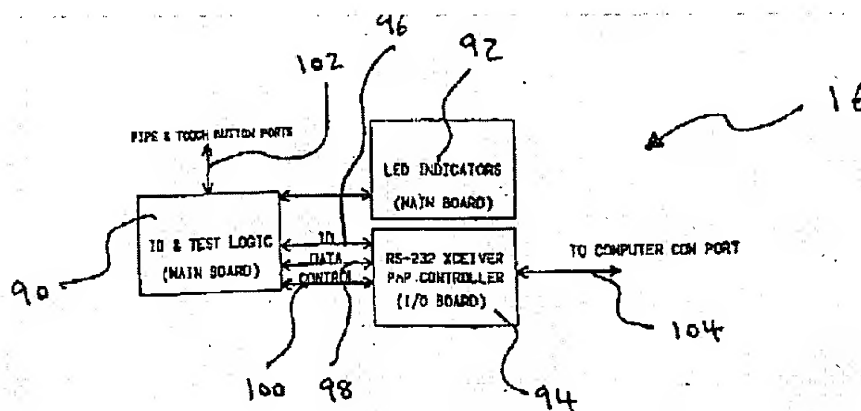
Fig. 4

Applicants argue that Applicant's system does not require that the checkpoints be read in

any sequence but instead, it requires a specified visitation frequency, such as once per hour or

twice per day, be specified for each checkpoint because this allows checkpoints to be visited in a

completely random order, while the Holland system does not require checkpoints within a given

zone to be visited sequentially, it does require that the zones be visited in a predefined sequence.

The Examiner disagrees with Applicants. It is noted that the features upon which applicant relies

(i.e., the system requires a specified visitation frequency, such as once per hour or twice per day,

be specified for each checkpoint) are not recited in the rejected claim(s). Although the claims

are interpreted in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants argue that the Holland et al.'s system refers only to "messages" and not to

graphical data such as photographs or maps, that the patent gives a detailed description of the

preferred embodiments of their invention, and that it should be noted that: (1) The requirement of

a display on the portable: data collection device is different than Applicant's system which

requires no such display; (2) The specific device to which Holland, et al., refers contains a

display that supports two lines of 16 characters each. It cannot display photographs; (3) This

section also describes Holland's method of assigning different priorities to checkpoints and how

the priorities are used in their system, Applicant's system does not associate priorities with

checkpoints; and (4) Holland also describes the ordering of "zones" which may in turn contain

unordered checkpoints Applicant's system does not require that the checkpoints be read in any

sequence. The Examiner disagrees with Applicants. The examiner broadly interprets the claimed

language differently from Applicant. "computer readable program code means (report generating

software 22 shown on Fig. 1) for printing one or more reports to a printer of the information

obtained from one or more checkpoints during a guard patrol, reports comprising customization

selected from the group consisting of logos, cover sheets, photographs, detailed headings,

watermarks, bitmaps, drawings, illustrations, trademarks and patrol statistics" disclosed in claim

1, Applicants only claimed for printing one or more reports regarding obtained information of

checkpoints during a guard patrol in a selected format, such as logos, cover sheets, photographs,

detailed headings, watermarks, bitmaps, drawings, illustrations, trademarks or patrol statistics;

however, the Examiner could not find anywhere in the claim 1 that Applicants have indicated

any language related to features, such as "does not associate priorities with checkpoints" and "

the system does not require the checkpoints be read in any sequence". Therefore, based on

Applicants' claimed language, Holland et al. do disclose computer readable program code means

(report generating software 22 shown on Fig. 1) for printing one or more reports to a printer of

the information obtained from one or more checkpoints during a guard patrol, reports comprising

customization selected from the group consisting of logos, cover sheets, photographs, detailed

headings, watermarks, bitmaps, drawings, illustrations, trademarks and patrol statistics (see

Tables 1-3; Figs. 14 and 15; col. 2, line 67 to col. 3, line 24; and col. 9, line 20 to col. 10, line

15).

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
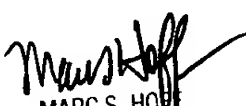
date of this final action.

Contact Information

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Carol S. Tsai whose telephone number is (703) 305-0851. The

examiner can normally be reached on Monday-Friday from 7:30 AM to 4:00 PM. If attempts to

reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can

be reached on (703) 308-1677. The fax number for TC 2800 is (703) 308-7382. Any inquiry of a

general nature or relating to the status of this application or proceeding should be directed to the

TC 2800 receptionist whose telephone number is (703) 308-1782.

In order to reduce pendency and avoid potential delays, Group 2800 is encouraging

FAXing of responses to Office actions directly into the Group at (703) 308-7382. This practice

may be used for filing papers not requiring a fee. It may also be used for filing papers which

require a fee by applicants who authorize charges to a PTO deposit account. Please identify the

examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 2800

will be promptly forwarded to the examiner.

Carol S. Tsai

12/22/03

MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800